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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,595	07/29/2002	Ju-Nan Chang	IACP0005USA	5127

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NORTH AMERICA INTERNATIONAL PATENT OFFICE (NAIPC)

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EXAMINER

NGUYEN, CINDY

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,595

Applicant(s)

CHANG ET AL.

Examiner

Cindy Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to amendment filed 05/17/05.

Response to Arguments

Applicant's arguments filed 05/17/05 have been fully considered but they are not persuasive.

Applicant argued that Russell does not actually disclose "a plurality of configuration tables". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Art Unit: 2161

Response to Applicant argument in claim 10, Russell does not mention randomly selecting an identity when none of the received identities can be found in a table.

However, the limitation was not claimed.

Regarding new claim 13, please the rejection as below.

Response to Applicant argument "comparing the predetermined identity of the chosen configuration table with the identities received, and if any of the plurality of identities received matches the predetermined identity, then choosing an identity according to the sorting pointer corresponding to the status pointer as comparing the address within the packet against the appropriate identification number of the possible N number of termination devices, comparing the destination address within the wrapped packet against the identification number of a termination device selectable coupled to the exit module, when the comparison yields a match, the packet is connect to the appropriate termination device see col. 15, lines 35-44 and col. 21, lines 1-15, Mahalingaiah.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

Art Unit: 2161

possession of the claimed invention. Claim 13 contains subject matter "user preferences" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell (US 20040249915) in view of Mahalingaiah (US 6754214).

Regarding claim 1, Russell discloses: A method for controlling a network connection of the terminal in a wireless network system, the terminal capable of wirelessly transmitting and receiving data, the wireless network system comprising a plurality of wireless networks, the different wireless networks having different identities capable of being transmitted wirelessly by each wireless network, the terminal comprising:

a plurality of distinct sorting pointers, each distinct sorting pointer

representing a unique priority¹ (page 6, 0076, Russell);

a network database for recording a plurality of predetermined identities (fig. 2D and corresponding text, Russell);

a plurality of configuration tables, each configuration table for corresponding one predetermined identity to one unique sorting pointer, and each configuration table having at least a unique predetermined identity which corresponds to a sorting pointer (tables in fig. 2C-E, Russell); and a status pointer for representing an operational location and time (page 5, 0061, Russell); the method comprising:

receiving identities of the plurality of wireless networks via wireless transmission (page 9, 0096, Russell);

However, Russell didn't disclose: choosing a configuration table from the plurality of configuration tables according to the status pointer; comparing the predetermined identity of the chosen configuration table with the identities received, and if any of the plurality of identities received matches the predetermined identity, then choosing an identity according to the sorting pointer corresponding to the status pointer. On the other hand, Mahalingaiah discloses: choosing a configuration table from the plurality of configuration tables according to the status pointer (col. 20, lines 62-67, Mahalingaiah); comparing the predetermined identity of the chosen configuration table with the identities received, and if any of the plurality of identities received matches the predetermined identity, then choosing an identity according to

¹ Sorting pointers as access priority table in fig 2E, the priority of contracted network had been sorting in

Art Unit: 2161

the sorting pointer corresponding to the status pointer (col. 21, lines 1-15, Mahalingaiah). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the steps for comparing the predetermined identity of the chosen configuration table with the identities received, and if any of the plurality of identities received matches the predetermined identity, then choosing an identity according to the sorting pointer corresponding to the status pointer in the system of Russell as taught by Mahalingaiah. The motivation being to enable the system provided the module which contains one mapping table selectable by the security code transferred with the packet that arrives on the module and the termination device connected to the module and receives the packet arriving upon that module.

In addition, Russell/ Mahalingaiah discloses: wirelessly connecting to the wireless network corresponding to the chosen identity (page 6, 0078, Russell).

Regarding claim 2, all the limitation of this claim has been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: wherein when choosing an identity according to the matched sorting pointer corresponding to the predetermined identity, the predetermined identities matching the chosen identity have sorting pointers with higher priorities (page 9, 0097, Russell).

order as 1...K, and each of contracted Networks is unique priority.

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: wherein the network database has a plurality of key IDs stored in the database with each of key IDs corresponding to a predetermined identity (table in fig. 2D, Russell); and when wirelessly connecting to the wireless network which is corresponding to the chosen identity (page 6, 0078, Russell), data being uploaded or downloaded between the terminal and the wireless network is encrypted according to the key ID corresponding to the network identity (page 5, 0068, Russell).

Regarding claim 4, all the limitations of this claim have been noted in the rejection of claim 3 above. In addition, Russell/Mahalingaiah discloses: wherein when connecting to the wireless network corresponding to the chosen identity via wireless transmission, a certification program is first processed, then the data being uploaded or downloaded between the terminal and the wireless network is encrypted according to the key ID which is corresponding to the wireless identity (page 6, 0074, Russell).

Regarding claim 5, all the limitation of this claim has been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: wherein each wireless network has at least an access point, and the identity of each wireless network is transmitted by the access point of each wireless network (page 6, 0068, Russell).

Regarding claim 6, all the limitation of this claim has been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: wherein the terminal is a notebook computer. wherein the terminal is a notebook computer (page 4, 0051, Russell).

Regarding claim 7, all the limitation of this claim has been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: wherein the plurality of wireless networks are capable of responding to a probe signal by wirelessly transmitting the identity corresponding to the wireless network (page 4, 0052, Russell), the method further comprising: sending out a probe signal through the terminal before receiving the plurality of identities of the wireless network via wireless transmission, and having the plurality of wireless networks respond to their own corresponding identities to make the terminal capable of receiving the identities corresponding to the plurality of wireless networks (page 8, 0094, Russell).

Regarding claim 8, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: wherein each of the wireless networks is capable of continuously sending out a beacon signal comprising a corresponding identity of the wireless network, and the terminal is capable of receiving the plurality of identities corresponding to the wireless networks (page 5, 0060, Russell).

Regarding claim 9, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: further comprising: choosing an identity via a predetermined method when comparing the predetermined identities of the chosen configuration table to the identities received from the terminal results in no received identities being identical to any of the predetermined identities (page 8, 0088, Russell).

Regarding claim 10, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Russell/Mahalingaiah discloses: wherein the predetermined method chooses an identity randomly (page 7, 0079, Russell).

Regarding claim 11, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Russell/Mahalingaiah discloses: further comprising: wirelessly connecting to the wireless network which is corresponding to the chosen identity; and updating the chosen configuration table according to the chosen identity (page 7, 0085, Russell).

Regarding claim 12, all the limitation of this claim has been noted in the rejection of claim 11 above. In addition, Russell/Mahalingaiah discloses: further comprising: updating all configuration tables according to the chosen identities (page 7, 0085, Russell).

Regarding claim 13, all the limitation of this claim has been noted in the rejection of claim 1 above. In addition, Russell/Mahalingaiah discloses: wherein each configuration table corresponds to a unique list of prioritized user preferences for a specific operational time and physical location of the terminal. (col. 18, lines 15-48, Mahalingaiah).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

Art Unit: 2161

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CN
Cindy Nguyen
July 21, 2005

Frantz Coby
FRANTZ COBY
PRIMARY EXAMINER